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OFFICE OF PETITIONS

In re Application of	:	
James T. St. John et al.	:	
Application No. 09/759,671	:	DECISION ON PETITION
Filed: January 12, 2001	:	UNDER 37 C.F.R. § 1.137(A)
Attorney Docket Number: P12541	:	
(8194-470)	:	
Title: METHODS, SYSTEMS AND	:	
COMPUTER PROGRAM PRODUCTS FOR	:	
BANDWIDTH ALLOCATION BASED ON	:	
THROUGHPUT GUARANTEES	:	

This is a decision on the petition filed August 31, 2007, pursuant to 37 C.F.R. § 1.137(a)¹, to revive the above-identified application.

The petition is **DISMISSED**.

Background

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 19, 2005, which set a shortened statutory period for

¹ A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

reply of three months. No extensions of time are permitted for transmitting issue or publication fees². Accordingly, the above-identified application became abandoned on December 20, 2005. A Notice of Abandonment was mailed on February 10, 2006.

With the present petition, Petitioner has submitted the petition, issue, and publication fees, along with a statement of facts. Petitioner has met requirements (1) and (2) of 37 C.F.R. § 1.137(a). The fourth requirement is not applicable.

Regarding the third requirement, a discussion follows.

The Applicable Standard

Nonawareness of a PTO rule will not constitute unavoidable delay³

The burden of showing the cause of the delay is on the person seeking to revive the application⁴.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁵

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁶

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action⁷.

² See MPEP §710.02(e).

³ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

⁴ Id.

⁵ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁶ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁷ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present⁸.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable⁹."

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions¹⁰. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133¹¹.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance himself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney¹²."

Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions¹³."

8 In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

9 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

10 Link v. Wabash, 370 U.S. 626, 633-634 (1962).

11 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

12 Link at 633-634.

13 Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account"¹⁴.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable"¹⁵.

The Relevant Law and Regulations

35 U.S.C. § 133: Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. § 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

¹⁴ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

¹⁵ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

Analysis

The relevant events are as follows:

- On February 12, 2004, the former attorney of record, a member of the law firm Myers, Bigel, Sibley, and Sajovec PA (hereinafter referred to as "the firm") submitted a request for withdrawal at attorney pursuant to 37 C.F.R. § 1.36.
- On April 19, 2004, the Assignee submitted a Power of Attorney and Correspondence Address Indication Form along with a Statement Under 37 C.F.R. § 3.73(b).
- On June 4, 2004, the Technology Center mailed a decision, granting the firm's request and indicating "all future correspondence will continued to be directed to the above address until such time as a request for change of address is filed," with the "above address" being the address of the Assignee.
- On April 5, 2005, a non-final Office action was mailed not to the Assignee, but rather to the firm.
- On July 5, 2005, a response to the non-final Office action was received. It is noted that this response was submitted not by the firm, but rather by the Assignee, and bears Petitioner's signature. As such, it appears that the non-final Office action was forwarded to the Assignee by the firm.
- On September 19, 2005, a Notice of Allowance and Issue Fee Due was mailed to the firm.

Petitioner (the Assignee) has asserted that the Notice of Allowance and Issue Fee Due was not received "because the USPTO mailed the Notice to the wrong address."

It is noted that on April 19, 2004, the Assignee instructed the Office to direct all correspondence to the same. Office records have been reviewed, and it does not appear that the correspondence address was updated subsequent to the receipt of the aforementioned Power of Attorney and Correspondence Address Indication Form.

The fact that the Assignee responded to the non-final Office action strongly suggests that it was received by the Assignee.

A review of the response to the non-final Office action indicates that Petitioner executed this submission, and the response bears the Assignee's name and address as the return address below his signature. A review of the non-final Office action indicates that the cover sheet of the same bears the name and address of the firm as the mailing address. As such, it is clear that Petitioner either knew or should have known that the communication was mailed to the firm. However, the response to the non-final Office action has been reviewed, and it does not appear that Petitioner notified the Office of the failure to update the correspondence address.

As set forth above, the entire period of delay cannot be deemed to have been "unavoidable" where the Applicant failed to exhibit the level of care or diligence that is "generally used and observed by prudent and careful men in relation to their most important business."

It does not appear that Petitioner exhibited "the level of care or diligence that is generally used and observed by prudent and careful men in relation to their most important business." It appears that Petitioner either was aware or should have been aware of the Office's failure to update the correspondence address, and yet Petitioner prepared a response to the non-final Office action, and failed to bring this fact to the Office's attention. It seems that an ordinary man, acting in relation to his most important business, would have brought this fact to the Office's attention via the inclusion of a statement in the response to the non-final Office action (if for no other reason than if one paper was mailed to the firm, there was a strong likelihood that subsequent mailings would also be addressed to the firm).

CONCLUSION

The correspondence address of record and attorney docket number have been updated.

On renewed petition, Petitioner will need to explain how the failure to notify the Office of its failure to update the correspondence address, when he either knew or should have known of the same, amounted to "the level of care or diligence that is generally used and observed by prudent and careful men in relation to their most important business."

Any reply must be submitted within TWO MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a)

are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹⁶, hand-delivery¹⁷, or facsimile¹⁸. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web¹⁹.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225²⁰. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski
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Office of Petitions
United States Patent and Trademark Office

16 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

17 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

18 (571) 273-8300- please note this is a central facsimile number.

19 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

20 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.